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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/693,400	10/24/2003	Armin Schorer	50316/01001	1926

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CLARK & ELBING LLP
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BOSTON, MA 02110

EXAMINER

FLANAGAN, BEVERLY MEINDL

ART UNIT PAPER NUMBER

3739

DATE MAILED: 07/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/693,400

Applicant(s)

SCHORER, ARMIN

Examiner

Beverly M. Flanagan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4,5,7-11,13 and 14 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4,5,7-11,13 and 14 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.


Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.


BEVERLY M. FLANAGAN
PRIMARY EXAMINER

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 6/29/05.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Information Disclosure Statement

The information disclosure statement filed June 29, 2005 has been made of record and the references cited therein have been considered by the examiner.

Entry of Amendment

The amendment filed May 20, 2005 has been entered and made of record. Accordingly, the status of the claims is as follows: Claims 1, 2, 4, 5 and 7-11, 13 and 14 are pending; Claims 3, 6 and 12 are canceled.

Withdrawal of Previously Set Forth Grounds of Rejection

The 35 U.S.C. § 103(a) rejection of claims 1, 2, 4, 5 and 7-14 as being unpatentable over Sakamoto (U.S. Patent No. 6,095,972) in view of Bullard (U.S. Patent No. 5,665,052) is hereby **withdrawn**. The 35 U.S.C. § 103(a) rejection of claim 9 as being unpatentable over Sakamoto (U.S. Patent No. 6,095,972) in view of Bullard (U.S. Patent No. 5,665,052) and further in view of Rothfels (U.S. Patent No. 5,873,818) is hereby **maintained**. The 35 U.S.C. § 112, second paragraph rejection of claims 12 and 13 has been **overcome**.

The following new grounds of rejection are set forth:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 4, 5, 7-11, 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sakamoto (U.S. Patent No. 6,095,972) in view of Bullard (U.S. Patent No. 5,665,052) and further in view of Rothfels (U.S. Patent No. 5,873,818).

In regard to claims 1, 11 and 13, Sakamoto teaches a laryngoscope with a blade 10 with an upper blade tip 12 and a lower blade tip 14 that are pivotally secured to upper tip flange 38 at pivot connection 13 and to lower tip flange 36 at pivot connection 16 (see Figure 2). Figures 2, 7 and 8 show that blade tips 12 and 14 comprise a flat element and have a thickened, rounded lip. Sakamoto teaches provision of a conventional light source 34 that may also be part of a fiber optic circuit, fixable within the blade and either stiff, flexible or removeable, as is known in the art (see col. 4, lines 25-34). Bullard discloses a similar laryngoscope device comprised of a stylet 60 that has a flexible guide member 66 removably passed through it during a procedure, where the guide member may comprise a medical optical apparatus (see col. 4, lines 54-60). Bullard thus demonstrates that removable optical components for a laryngoscope are well known and conventional in the art. Furthermore, it has been held that constructing a formerly integral structure in various elements involves only routine skill in the art. *Nerwin v. Erlichman*, 168 USPQ 177, 179. Accordingly, it would have been obvious for

one of ordinary skill in the art at the time the invention was made to make the light source 34 of Sakamoto removable, in the manner disclosed by Bullard. **With further respect to claim 1 and in regard to claim 9**, Sakamoto is silent as to a wide angle lens as part of the fiber optic circuit. However, Rothfels discloses a similar laryngoscope 10 having an optical system 44 with a prism-lens 50 with a concave portion 56 that serves to produce a wide-angle view, thus creating a highly expanded viewing region (see col. 3, lines 19-50). Within this expanded viewing region would inherently be the viewing angles in the range of 0 to 75 degrees. Rothfels thus demonstrates that laryngoscopes provided with optical systems incorporating wide angle lenses are well known in the art. Accordingly, it would have been obvious for one of ordinary skill in the art at the time the invention was made to provide the fiber optic circuit of Sakamoto with the wide angle prism-lens disclosed by Rothfels, in the interest of equipping the laryngoscope with a highly expanded viewing region.

In regard to claim 2, Sakamoto teaches a thumb plunger 20 that actuates a push rod 22 and a spring 28 to pivot blade tips 12 and 14 (see Figure 2). **In regard to claims 5, 7 and 8**, Sakamoto teaches provision of a conventional light source 34 that may also be part of a fiber optic circuit, fixable within the blade and either stiff or flexible, as is known in the art (see col. 4, lines 25-34). **In regard to claim 4**, Figure 27 shows an alternate embodiment with a curved blade 10 where the light emission output at the distal end of blade 10 would be inclined to a longitudinal axis of the optical device. **In regard to claim 10**, Sakamoto teaches that the laryngoscope is provided with a light source 34 having a light source conduit 60 that connects the power source in handle 26

with the transmission source in blade 10 (see Figure 23 and col. 4, lines 25-34). **In regard to claim 14**, as broadly as claimed, the thumb plunger 20 of Sakamoto is capable of being operated in a direction that is perpendicular to the longitudinal axis of the handle. Applicant has not recited specific structure in the instant invention to support the intended use recitation.

Response to Arguments

Applicant's arguments filed with the amendment of May 20, 2005 have been fully considered but they are not persuasive.

Applicant argues that the combination of Sakamoto in view of Bullard does not teach a wide angled lens. However, this argument is effectively addressed in the new rejection set forth above.

Applicant further argues that a skilled person combining the prism lens of Rothfels with the laryngoscope shown in Bullard would be motivated to integrate the wide-angled lens in the fixed optical device that includes channels 38 and 40 of Bullard, as Rothfels does not teach or suggest a removable optical apparatus. It should be noted that the primary reference is Sakamoto and, according to the rejection set forth above, the prism lens of Rothfels would be applied to the device of Sakamoto, not the device of Bullard. Bullard is combined with Sakamoto to demonstrate the teaching of removability. It should be further noted that Sakamoto also recognizes the use of conventional optical components, which include removable components, as taught by Bullard (see above). Finally, Rothfels is not utilized as a teaching for removability, but

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rather as a teaching for the use of wide angled lenses in laryngoscopes. The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). The teaching of Sakamoto, Bullard and Rothfels, combined, suggest an laryngoscope with a removeable wide angle lens.

In response to applicant's argument that there is no desirability to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation to combine the Sakamoto, Bullard and Rothfels references is imbedded in Rothfels, where Rothfels teaches the desirability of using a wide angle lens to expand the viewing region (see col. 3, lines 19-50 of Rothfels).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

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§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

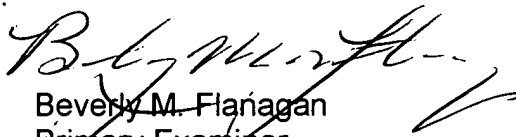
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Beverly M. Flanagan whose telephone number is (571) 272-4766. The examiner can normally be reached on Mondays, Tuesdays and Thursdays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C.M. Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Beverly M. Flanagan
Primary Examiner
Art Unit 3739
